

**REMARKS**

The present amendment is in response to the Office Action dated September 27, 2004, where the Examiner has rejected claims 1-18. By the present amendment, claim 1 has been amended, claim 18 has been cancelled, and claims 19 and 20 have been added. Accordingly, claims 1-17 and 19-20 are pending in the present application. Reconsideration and allowance of pending claims 1-17 and 19-20 in view of the amendments and the following remarks are respectfully requested.

**A. CLAIM REJECTIONS UNDER 35 U.S.C. §101 – OBVIOUSNESS-TYPE DOUBLE PATENTING**

The Examiner has rejected claims 1, 6, and 16 under 35 U.S.C. §101 “Obviousness-Type Double Patenting” as being unpatentable over claims 1 and 2 of United States Patent No. 6,727,786. In response, applicant has amended base claim 1, thereby rendering the double patenting rejection of independent claim 1, and dependent claims 6 and 16, moot.

**B. OBJECTIONS TO THE SPECIFICATION**

The Examiner has objected to the Specification citing inconsistencies between the Brief Description of the Drawings, and the corresponding Figures. Specifically, the Examiner has pointed out that the Drawings and the Brief Description of the Drawings depict different Frequencies. In response, Applicant has amended the Brief Description of the Drawings related to Figures 4-7 to reflect what is shown in the Drawings, as well as what is discussed elsewhere in the Specification.

The Examiner also identified an omitted reference to Figure 8 in the Brief Description of the Drawings. In response, Applicant has amended the Specification to include an appropriate statement regarding Figure 8. No new matter has been added.

**C. ASSERTION OF ADMITTED PRIOR ART**

It is respectfully noted that the Examiner has made several rejections based on "Applicant's Admitted Prior Art (AAPA)". Apparently this assertion of admission has been made based on the submission of an Information Disclosure Statement (IDS) along with the filing of the application. However, the IDS, submitted on form PTO 1449, was accompanied by a transmittal which stated clearly:

"The items identified in this IDS may or may not be "material" pursuant to 37 CFR 1.56. *The submission thereof by Applicants is not to be construed as an admission that any such patent, publication, or other information referred to therein is material or considered to be material (37 CFR 1.97 (h)), or even qualifies as "prior art" under 35 USC 102 with respect to this invention unless specifically designated by Applicant as such.*" (emphasis added)

Applicant asserts that no admission as to any prior art has been made in this application. In light of the assertions by the Examiner that the references submitted were indeed admitted prior art, an appropriate comment regarding the erroneous assertion is respectfully requested.

**D. CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 1, 3–5, 7–15, and 17 under 35 U.S.C. §103 as being unpatentable over Sroka (U.S. Pat. No. 5,227,748) in view of Yamada et al. (U.S. Pat. No. 6,522,220), and Tsuda (U.S. Pat. No. 6,018,282). Applicant respectfully disagrees; however, in order to expedite the prosecution of the present application, applicant has amended independent claims 1, as discussed below. For the reasons that follow, applicant respectfully submits that claims 1–17 are patentably distinguishable over the cited references, considered singly or in combination.

In the Office Action, the Examiner acknowledges Sroka as deficient with regard to the rejection of claim 1 (See Office Action page 4) and, thus, relies on a combination of Yamada and Tsuda to form a basis for rejection of claim 1 under §103. More specifically, with regard to Claim 1, the Examiner cites Figure 1 of Yamada (See Office Action, page 4, lines 16-18) as disclosing switchable resonators, with D11 and D12 purportedly being the switching elements based upon cross-reference to Figures 4A and 4B of Yamada. Applicant points out that in that Figure 1, D11 is coupled to resonator 12 via C13 at the junction between C11 and resonator 12 (this junction will be referred to as a "first end" of resonator 12). However, the "second end" of resonator 12 is permanently shunted to ground.

Claim 1, however, as amended, recites a switch interposed between the "second end" of resonator 16 and ground (See Figure 1 of the application). Claim 1 has been amended to specifically recite the position of the switching element. Thus, Applicant respectfully submits that the arrangement of the switches as specified by amended claim 1 is directly to a substantially different structural configuration and operates substantially differently from that of Yamada. Applicant, notes, for example, in increased complexity of the circuitry required by arrangement of Yamada.

The Examiner also asserts (See Office Action page 4, lines 19-21) that Tsuda suggests that ferroelectric (FE) capacitors are interchangeable with other types of variable capacitors (e.g. varactors). Applicant respectfully asserts that this assertion is only true in light of Applicant's own disclosure. Indeed, FE capacitors provide variable capacitance; however, FE capacitors have conventionally been known to have high insertion loss. Thus, an FE capacitor would not necessarily be used by one skilled in the art to replace a varactor since the knowledge in the art, prior to the present invention and its related cases, holds that FE capacitors are functionally inefficient. For this reason, the teachings of any asserted prior art would arguably mandate against, and teach away from, use of an FE capacitor as a proper replacement of a varactor. Consequently, Applicant respectfully disagrees with the Examiner's use of Tsuda as a basis for modification of the primary reference Sroka. For these reasons, Applicant

respectfully asserts that claim 1, as amended, is patentably distinguishable over the cited references.

With regard to claims 2-17, the Examiner has also rejected these claims under 35 U.S.C. §103. Applicant asserts that the amendment above to claim 1 results in an allowable claim 1. Because claims 2-17 depend either directly or indirectly from now allowable claim 1, applicant asserts the §103 rejection is moot, and dependent claims 2-17 are likewise allowable.

**D. CLAIM REJECTIONS UNDER 35 U.S.C. § 101 - “SAME INVENTION”**

With regard to claim 18, the Examiner has rejected claim 18 under 35 U.S.C. §101 – “same invention” double patenting over claim 3 of U.S. Patent No. 6,727,786. In response, Applicant has cancelled claim 18.

**E. NEW CLAIMS**

Applicant has added independent claim 19 that includes the limitation of a second switch that switches between a first configuration in which a second ferroelectric component is coupled to the ferroelectric tunable component, and a second configuration where it is not coupled. Support for this amendment is found in the Specification on page 18, lines 4-20, and in Figure 3C.

Applicant respectfully asserts that claim 19 is patentable over the combination of references presented by the Examiner in that none of the references teach or suggest the combination of a switchable filter and a separate switched ferroelectric component.

New claim 20 has been added to depend from claim 19, and includes a second ferroelectric component electromagnetically coupled to the second switch wherein the second ferroelectric component is coupled to the ferroelectric tunable component in the

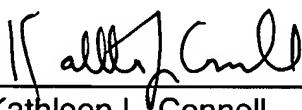
second configuration. Support for this amendment is found in the Specification on page 18, lines 4-20, page 19, lines 7-14, and in Figure 3D.

**F. Conclusion**

For all the foregoing reasons, an early allowance of claims 1-17 and 19-20 pending in the present application is respectfully requested.

Respectfully Submitted,

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